

## **REMARKS**

This paper is presented in response to the Office Action. Claims 1-20 remain pending in this application.

Reconsideration of the application is respectfully requested in view of the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicant notes that the remarks presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

### **II. Rejection of Claims 1-3, 7-10, and 12-20 under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 1-3, 7-10, and 12-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,991,381 to Kropp ("*Kropp*") in view of what the Examiner considers to be obvious to one of skill in the art. Applicant respectfully disagrees.

With regard to claim 1, the Examiner has conceded that *Kropp* fails to teach the claim 1 limitation "the driver circuit being formed as a circuit integrated into the carrier substrate, [and] the monitor component likewise being integrated into the carrier substrate." Although never explicitly stating so, the Examiner seems to imply that it would be obvious to have the driver circuit and the monitor component of *Kropp* be integrated into the same substrate. Particularly, the Examiner has stated that *Kropp* "does show printed circuit #6 on substrate #14, while photodiode on substrate #4 ... and further discloses ... that the substrate of the detection device and laser can be the same material such as silicon or sapphire." In setting forth the apparent basis for the rejection, the Examiner then asserts that "rearranging parts of an invention involves only routine skill in the art, since such modification would have involved a mere change in the size of a component or its compactness such as to reduce cost in making multiple components."

As a preliminary matter, Applicant notes that the Examiner has failed to state precisely what the Examiner believes to constitute the purportedly obvious modification of *Kropp*. Even if, as alleged by the Examiner, *Kropp* discloses that the substrates for the detection device and laser can be made of the same material, such a disclosure, without more, is an inadequate basis for a conclusion that it would be obvious to position the printed circuit and photodiode purportedly disclosed in *Kropp* on the same substrate so as to arrive at the claimed invention. In general, items can consist of identical materials but can be completely separate items. Thus, simply purporting that two elements are made of the same material is not enough to support the conclusion that it would be obvious to combine those elements into a single element. Moreover, the Examiner has failed to establish any relevance of the detection device and laser substrate construction to the positioning of the printed circuit and photodiode.

In connection with the foregoing, Applicant notes that the Examiner has failed to even allege that the printed circuit and the detection device purportedly disclosed in *Kropp* can be "integrated into [a] carrier substrate," as claim 1 requires. Instead, as noted above, the Examiner has asserted with respect to *Kropp* that the laser substrate can be made of the same material as the detection device substrate. It is not clear to Applicant how that assertion has any bearing with respect to the driver circuit and monitor component recited in claim 1.

With respect to the purported motivation for the allegedly obvious modification of *Kropp*, Applicant notes that the Examiner has not established the existence of a suggestion or motivation to modify *Kropp* in the purportedly obvious manner asserted by the Office Action, but has instead asserted,

as noted above, that "rearranging parts of an invention involves only routine skill in the art, since such modification would have involved a mere change in the size of a component or its compactness such as to reduce cost in making multiple components." However, Applicant notes that "the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of [the] specification to make the necessary changes in the reference device." MPEP § 2144.04(VI)(C). *Emphasis added.* As noted above, however, the Examiner has failed to establish the existence of a suggestion or motivation to make the allegedly obvious modification of *Kropp*.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1, at least because the Examiner has failed to establish that modification of *Kropp* would produce the claimed invention, and because the Examiner has failed to establish the existence of a suggestion or motivation to modify the *Kropp* device so as to arrive at the claimed invention. Applicant thus respectfully submits that the obviousness rejection of claim 1 should be withdrawn.

By virtue of their dependence from claim 1, claims 2-20 include all the limitations of claim 1. Applicant thus respectfully submits that for at least the reasons outlined herein in the discussion of claim 1, the rejection of claims 2-20 lacks an adequate basis and should accordingly be withdrawn.

### III. Request for Examiner Affidavit

In connection with the foregoing, Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 10, 12, 17, 18 and 19. With regard to claims 10 and 12, the Examiner has simply stated that "It is well-known to have plurality of lasers formed in an array for the advantages benefit of increasing the output power, for example useful in laser printer applications." As to claims 17-19, the Examiner has simply stated that "It is within one skill in the art to recognize that the detection device and circuit can co-exist in the same substrate and having the drive circuit and monitor component integrated into the same carrier substrate is within one skill in the art, to reduce components and for compactness."

Notwithstanding the aforementioned assertions made by the Examiner in connection with the rejections of claims 10, 12, 17, 18 and 19, the Examiner has not identified any references or other materials as being obvious to combine with the purported teachings of *Kropp*. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon

which the obviousness rejection of claims 10, 12, 17, 18 and 19 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 10, 12, 17, 18 and 19.

#### **IV. Allowable Subject Matter**

The Examiner has indicated that claims 4-6 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.<sup>1</sup> In light of the discussion herein, Applicant respectfully declines to amend claims 4-6 and 11 at this time.

Applicant submits the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicant agrees with the Examiner that the inventions to which claims 4-6 and 11 are respectively directed are patentable over the cited references, but respectfully disagrees with the Examiner's statement of reasons for allowability as set forth in the Office Action.

Particularly, Applicant submits that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, the patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicant does not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claim allowable and Applicant does not make any admission or concession concerning the Examiner's statements in the Office Action concerning the allowability of claims 4-6 and 11 in view of the cited references.

#### **V. Change in Attorney Docket No.**

Applicant respectfully notes that the Office Action references Attorney Docket No. "MAIKP122US." Pursuant to the Change of Attorney Docket Number filed in this case on May 31, 2006, the correct docket number for this case is 16274.180. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communications from the USPTO reference docket number 16274.180.

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<sup>1</sup> The Office Action indicates that claims 4, 5, and 11 are objected to as being dependent upon a rejected base claim. However, the Office Action Summary page indicates that claim 6 is also objected to, and the Office Action gives no further indication as to the basis for the objection to claim 6. Since claim 6 depends from claim 5, which is objected to as being dependent upon a rejected base claim, Applicant assumes that claim 6 is also objected to as being dependent upon a rejected base claim.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-20 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 22<sup>nd</sup> day of June, 2006.

Respectfully submitted,



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